

REMARKS

In the Final Office Action, the Examiner rejected claims 1, 2, 15, and 19 under 35 U.S.C. § 112, second paragraph; rejected claims 1, 10, 15, 17, and 19 under 35 U.S.C. §102(e) as being anticipated by Tsukamoto et al. (U.S. Patent No. 6,559,964); rejected claim 4 under 35 U.S.C. §103(a) as being unpatentable over Tsukamoto et al.; rejected claims 2, 3, 5, 7, 9, 11-14, 16, and 18 under 35 U.S.C. §103(a) as being unpatentable over Tsukamoto et al. in view of Unno (U.S. Patent No. 6,437,875); rejected claim 6 under 35 U.S.C. §103(a) as being unpatentable over Tsukamoto et al. and Unno and further in view of Mori et al. (U.S. Patent No. 6,292,267); and rejected claim 8 under 35 U.S.C. §103(a) as being unpatentable over Tsukamoto et al. in view of Okamura et al. (U.S. Patent No. 6,266,162.) Based on the following reasoning, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. § 112, § 102(b), and § 103(a).

I. The Rejection of Claims 1, 2, 15, and 19 Under 35 U.S.C. § 112.

Regarding the rejection of claims 1, 2, 15, and 19 under 35 U.S.C. § 112, 2nd paragraph, Applicants propose that claims 1, 2, 15, and 19 be amended as indicated above. Support for these amendments is provided, for example, on page 9, line 26-page 10, line 5 and page 16, line 18-page 17, line 7 of Applicants' specification. Accordingly, Applicants request the Examiner to withdraw the rejections of claims 1, 2, 15, and 19 under 35 U.S.C. § 112, 2nd paragraph.

II. The Rejection of Claims 1, 10, 15, 17, and 19 Under 35 U.S.C. § 102.

Claims 1, 10, 15, 17, and 19 were rejected under 35 U.S.C. §102(b) as being anticipated by Tsukamoto et al. Applicants respectfully traverse this rejection.

In order to support a rejection under 35 U.S.C. § 102(b), each and every element as set forth in the claims must be found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131. Tsukamoto et al. fails to teach each and every recitation of claim 1.

Claim 1 recites a combination including *inter alia*, a “storage means for storing the document image inputted by the at least one digital copier and information relating to the document image, wherein the at least one digital copier generates a title for the document image based on the information relating to the document image inputted.” Tsukamoto et al. fails to disclose or teach at least this limitation. The Examiner alleges, in the rejection of claim 5, that this element is taught by Tsukamoto et al. at col. 5, lines 29-40. (OA at 9.) However, the cited passages are silent as to generating “a title for the document image based on the information relating to the document image,” as recited in amended claim 1. The cited passages of Tsukamoto et al. disclose a mail box that contains a “mail box number . . . , a changed user name . . . , a changed identification ID . . . , and addresses of reception facsimile messages.” (Col. 5, lines 36-40.) However, these teachings fail to teach or suggest “wherein the at least one digital copier generates a title for the document image based on the information relating to the document image inputted,” as recited in claim 1. As such, claim 1 is allowable over Tsukamoto et al. Therefore, Applicants request the Examiner to withdraw the rejection of claim 1 and allow the claim.

Claims 10, 15, and 17 depend from claim 1. As explained, claim 1 recites elements not disclosed by Tsukamoto et al. Accordingly, claims 10, 15, and 17 are also allowable over Tsukamoto et al. for at least the same reasons as claim 1. Applicants, therefore,

respectfully request that the rejection of these claims under 35 U.S.C. § 102(e) be withdrawn and the claims allowed.

Claim 19, although of different scope, recites features similar to those discussed above with regard to claim 1. Applicants, therefore, submit that claim 19 is also allowable over Tsukamoto et al.

III. The Rejection of Claim 4 Under 35 U.S.C. § 103).

Claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over Tsukamoto et al. Applicants respectfully traverse this rejection because the Examiner has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." See M.P.E.P. § 2143.01 (8th Ed., Aug. 2001), quoting In re Wilson, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. See M.P.E.P. § 2143 (8th Ed. 2001), pp. 2100-122 to 127.

Claim 4 depends from claim 1 and, therefore, includes all the elements of claim 1. As explained, claim 1 recites elements not disclosed or suggested by Tsukamoto et al. Accordingly, claim 4 is also allowable over Tsukamoto et al. at least for the same reasons as claim 1.

IV. The Rejection of Claims 2, 3, 5, 7, 9, 11-14, 16, and 18 Under 35 U.S.C. § 103(a).

Claims 2, 3, 5, 7, 9, 11-14, 16, and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tsukamoto et al. in view of Unno. Applicants respectfully traverse this rejection because the Examiner has failed to establish a *prima facie* case of obviousness. Claim 2, 3, 5, 7, 9, 11-14, 16, and 18 depend from claim 1 and, therefore, include all the elements of claim 1. As explained, claim 1 recites elements not disclosed or suggested by Tsukamoto et al. Accordingly, claims 2, 3, 5, 7, 9, 11-14, 16, and 18 are allowable over Tsukamoto et al. at least for the same reasons as claim 1.

Furthermore, Applicants submit that Unno does not cure this deficiency. That is, the Examiner has also failed to show where Unno teaches or suggests “wherein the at least one digital copier generates a title for the document image based on the information relating to the document image inputted,” as recited in claim 1.

Since the cited references, taken either alone or in any reasonable combination, fail to teach or suggest each and every element required by claims 2, 3, 5, 7, 9, 11-14, 16, and 18, no *prima facie* case of obviousness has been made out with respect to those claims. Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claims 2, 3, 5, 7, 9, 11-14, 16, and 18 under 35 U.S.C. § 103(a) as being obvious from Tsukamoto et al. in view of Unno.

V. The Rejection of Claim 6 Under 35 U.S.C. § 103(a).

Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Tsukamoto et al. and Unno and further in view of Mori et al. Applicants respectfully traverse this rejection because the Examiner has failed to establish a *prima facie* case of obviousness. Claim 6 indirectly depends from claim 1 and therefore includes, at least, all

the elements of claim 1. As explained, claim 1 recites elements not disclosed or suggested by Tsukamoto et al. and Unno.

Furthermore, Mori et al. does not cure this deficiency. That is, the Examiner has also failed to show where Mori et al. teaches or suggests “wherein the at least one digital copier generates a title for the document image based on the information relating to the document image inputted,” as recited in claim 1.

Since the cited references, taken either alone or in any reasonable combination, fail to teach or suggest each and every element required by claim 6, no *prima facie* case of obviousness has been made out with respect to this claim. Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claim 6 under 35 U.S.C. § 103(a) as being obvious from Tsukamoto et al. and Unno and further in view of Mori et al.

VI. The Rejection of Claim 8 Under 35 U.S.C. § 103).

Claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over Tsukamoto et al. in view of Okamura et al. Applicants respectfully traverse this rejection because the Examiner has failed to establish a *prima facie* case of obviousness. Claim 8 depends from claim 1 and therefore includes all the elements of claim 1. As explained, claim 1 recites elements not disclosed or suggested by Tsukamoto et al.

Furthermore, Applicants submit that Okamura et al. does not cure this deficiency. That is, the Examiner has also failed to show where Okamura et al. teaches or suggests “wherein the at least one digital copier generates a title for the document image based on the information relating to the document image inputted,” as recited in claim 1.

Since the cited references, taken either alone or in any reasonable combination, fail to teach each and every element required by claim 8, no *prima facie* case of obviousness

has been made out with respect to this claim. Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claim 8 under 35 U.S.C. § 103 as being obvious from Tsukamoto et al. in view of Okamura et al.

VII. Conclusion.

In view of the foregoing, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of claims 1-19.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-19 in condition for allowance. Applicants submit that the proposed amendments to claims 1, 2, 5, 10, 15, and 19 do not raise any new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their claimed relationships were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

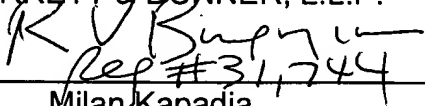
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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